UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHANNES-JORG RUEGER,
WOLFGANG STOECKLEIN and BERTRAM SUGG

Appeal No. 2004-1350
Application No. 09/824,193

ON BRIEF

Before OWENS, PAWLIKOWSKI, and NAPPI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

REMAND TO THE EXAMINER

This case is not ripe for meaningful review, and is therefore remanded to the examiner for appropriate action, consistent with the views expressed below.

On pages 3-4 of the answer, the examiner lists the following pending rejections:

Claims 1, 2, 8, 9, 18, 19, 25 and 26 stand rejected under 35 U.S.C. § 102(a) as anticipated by Moloney.

Claims 3-7, 10-14, 20-24, and 27-31 stand rejected under 35 U.S.C. § 103 as being obvious over Moloney in view of Takada or Jaenker.

Claims 15-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moloney in view of Takada or Jaenker, and further in view of Barron or Estevenon.

We first note that on page 3 of the answer, the examiner indicates that one of the rejections is under 35 U.S.C. § 102, however, does not indicate which paragraph. Based upon the rejection as set forth on page 2 of Paper No. 6, it appears that this rejection is under 35 U.S.C. § 102(a), and hence is listed as such, above. However, on page 18 of the brief, appellants list the rejection under 35 U.S.C. § 102(b). Clarification is required.

Furthermore, on page 6 of the reply brief, appellants indicate that the 35 U.S.C. § 103 rejection of claims 3-7, 10-14, 20-24, and 27-31 is in conflict with the claims that were rejected under this rejection in the final Office Action. Our review of the final Office action (mailed October 10, 2002), indicates that the examiner had rejected claims 3-7, 10-14, 20-24, and "10-31" under 35 U.S.C. § 103 as being obvious over Moloney in view of Takada or Jaenker. Appellants pointed out in the brief, on page 22, that possibly this was a typographical error, and the examiner intended to reject claims 3-7, 10-14, 20-24, and "30-31". However, as indicated on page 3 of the answer, the examiner has rejected claims 3-7, 10-14, 20-24, and "27-31" under 35 U.S.C. § 103 as being obvious over Moloney in view of Takada or Jaenker. Therefore, it is uncertain which claims are rejected in this rejection. Clarification is required.

Also, with respect to the stated rejection made on page 4 of the answer regarding claims 15-17 under 35 U.S.C. § 103 as being obvious over Moloney in view of Takada or Jaenker and further in view of Barron or Estevenon, the final Office Action (mailed October 10, 2002) indicates that this was a rejection of claims 15-17 and 32-34. Yet, the answer, on page 4, indicates that only claims 15-17 stand rejected. Clarification is required.

In further regard to the anticipation rejection of claims 1, 2, 8, 9, 18, 19, 25 and 26, appellants argue in the reply brief

on page 3, that the examiner's position made on page 3 of the answer regarding this rejection, for the first time, is directed to the inherency issue. We do observe that in the Office Action dated March 27, 2002 (Paper No. 6), the examiner's position is set forth on page 2, and the inherency issue is not discussed. Then, in the Office Action dated October 10, 2002, the examiner sets forth on page 3, his position in regard to this rejection, and the inherency issue is not discussed. A comparison of these positions with the position as set forth on page 3 of the answer does indicate a shift of the examiner's position. That is, the examiner never discussed inherency in these prior positions, yet does raise it in the answer.

Also, on pages 8-9 of the brief, appellants set forth a grouping of the claims, and for each rejection, appellants do argue certain dependent claims separately. Yet, the examiner, on page 2 of the answer, indicates that appellants' brief does not include a statement that certain claims do not stand or fall together. Re-evaluation of this position made by the examiner is required.

Furthermore, in regard to the arguments directed to separate claims for each of the rejections, we observe that the examiner's response to appellants' argument is set forth on pages 4-5 of the answer. The examiner does not respond to all of the arguments made by appellants, including arguments regarding the secondary references and dependent claims. The examiner only responds to some of the arguments made by appellants regarding Moloney. The examiner does not address any claims separately, as argued by the appellants. The examiner does not address the secondary references of Takada, Jaenker, Barron, and Estevenon. Answer, pages 4-5. This violates the guidelines as set forth on page 1200-16 of MPEP 1208 (Rev. August 2001), where it is disclosed that

"[t]he answer should contain a response to the allegations or arguments in the brief".

Furthermore, the examiner's position in each rejection as set forth on pages 3-4 of the answer, does not follow the guidelines discussed in MPEP § 706 and § 1208.

We particularly refer to page 1200-19 of MPEP § 1208, regarding the requirements of the examiner's answer, at (10)(c) and (d), where it is stated:

> (c) For each rejection under 35 U.S.C. 102, the examiner's answer, . . . shall explain why the rejected claims are anticipated . . . under 35 U.S.C. 102, **pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.** [emphasis only]
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> (d) For each rejection under 35 U.S.C. § 103, the examiner's answer shall:
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> (i) state the ground of rejection and **point out where each of the specific limitations recited in the rejected claims is found in the prior art** relied on in the rejection. [emphasis only]
>
> (ii) identify any difference between the rejected claims and the prior art relied on and
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> (iii) explain how and why the claimed subject matter is rendered unpatentable over the prior art. If the rejection is based upon a combination of references, the examiner's answer, or single action shall explain the rationale for making the combination.

We also refer to MPEP § 706.02(j) (page 700-46, 8th Ed., Rev. 2, May 2004). Here, more guidance is given regarding the proper content of an examiner's rejection under 35 U.S.C. § 103.

In view of the above, we remand this application to the jurisdiction of the examiner to reopen prosecution to clarify, correct, and provide further analysis and response, as discussed above.

We note that when prosecution is reopened by the examiner after an appeal, or reply brief has been filed, appellants must exercise one of the following options:

> (i) File a reply under 1.111, if the Office action is not final, or reply under 1.113, if the Office action is final, or
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> (ii) request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits . . . or other evidence are permitted.

See MPEP section 1208 (page 1200-16, 8th Ed. Rev. 1, August 2001).

This application, by virtue of its special status, requires an immediate action. MPEP 708.01(D)(8th Ed., Rev. 2, May, 2004). It is important that the Board be informed promptly of any action (abandonment, reopening prosecution, etc.) affecting this appeal in this application.

REMANDED

TERRY J. OWENS)
Administrative Patent Judge)
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BEVERLY A. PAWLIKOWSKI) BOARD OF PATENT
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